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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,479	02/15/2001	Glenn Petkovsek	USA-P-00-001	1689

7590 12/30/2004

Patents +TMS  
A Professional Corporation  
Third Floor  
1914 N. Milwaukee Avenue  
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EXAMINER
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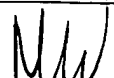
BORISOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/784,479	PETKOVSEK, GLENN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/04/2004 has been entered.

### ***Response to Amendment***

Amendment received on 07/29/2004 is acknowledged and entered. **Claims 1, 2, 5-10 and 12-14** have been amended. **Claims 1-18** are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. (US 2002/0120680 A1) (Greco) in view of Heston (US 2002/0019741 A1).**

Greco teaches a method and system for providing electronic document services, comprising:

**Claims 1 and 12,**

providing a service provider server and user (client) computer; said server and user computer are configured to communicate over the Internet; said user computer includes a browser to locate said service provider on the Internet [0006]; [0051]; [0089];

providing a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information relating to processing and delivery of a document (communication) by Internet-based document-related services (special service) [0012]-[0014]; [0051]; said information further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084];

inputting user unique information into the database via the user computer; wherein services recommended are selected based on a location (e.g., city, state, country) [0082]; [0084]; thereby obviously indicating utilizing demographic information;

selecting a type of communication by one of the users [0062]; [0084];

automatically delivering an item by one of said document-related service [0062] – [0069];

generating and transferring user fees, postage costs, and special service mail provider costs [0097].

Furthermore, Greco teaches that said server obtains necessary information from the user via convenient forms provided to the user [0089].

However, Greco does not specifically teach that said forms include *forms, which are used for creation said document* (communication).

Heston teaches a method and system for performing legal services over the Internet, wherein a client is presented with a choice of legal documents to be created. In use, the client selects the legal document that he wants to prepare, and enters into the legal document form necessary information to create the legal document [0105]; [0025]; [0006].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Greco to include that said database, residing in said service provider server remotely from the user computer, includes forms which are used

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for creation of a document, as disclosed in Heston, because it would advantageously simplify a whole process of creation of a document and delivering it to a recipient. Information as to *special* service is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

**Claim 2**, Greco teaches means for inputting information (260) by each of the users [0053];

**Claim 3**, Heston teaches a plurality of forms stored in the database, said forms are to be used in creation of a document [0027]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

Information as to *wherein the users may choose any one of the plurality of forms* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 3 are disclosed in Greco in view of Adams as described herein. Also as described the limitations of the claim 3 do not distinguish the claimed apparatus from the prior art.

Furthermore, Greco teaches:

**Claim 4**, a directory of addresses stored in the database [0013]; [0062].

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**Claim 5**, means for generating addresses necessary for delivery based on information input by the user [0062]; [0071].

**Claim 6**, means for generating communications based on the information input by the user [0012].

**Claim 7**, means for suggesting mailing requirements based on information input by the user [0012].

**Claim 8**, means for computing postage costs and fees to the user associated with delivery by the special service [0097].

**Claim 9**, means for contacting a supplier necessary to complete delivery of the communication by the special service [0046].

**Claim 10**, means storing information by each of the users [0082]; [0084].

**Claim 11**, means for generating a report for the user [0097].

**Claim 13**, determining required services for delivery by the special service and costs associated with the delivery [0012]; [0097].

**Claim 14**, providing links to web-sites of said Internet-based document-related service providers [0084] based on information input by the user [0012] and location information (e.g., city, state, country) [0082]; [0084]; thereby obviously indicating utilizing demographic information.

**Claim 15**, Heston teaches: generating the communication based on the information input by the user [0013]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

**Claim 16**, Heston teaches: providing the communication to the user via a display screen [0010]. The motivation to combine Greco with Heston would be to advantageously simplify a whole process of creation of a document and delivering it to a recipient.

**Claim 17**, Greco teaches: itemizing services taken by said Internet-based document-related service providers [0097].

**Claim 18**, Greco teaches: generating a report for the user [0097].

### **Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Response to Arguments***

Applicant's arguments in respect to claims 1-18 have been considered but are moot in view of new ground of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Adams (US 2001/0032178 A1) teaches a network based document origination method and system, wherein a document creation server refers to forms database to produce loan documents [0027].

Meltzer et al. (US 6,366,925 B1) teaches network based legal services method and system wherein immigration and naturalization related documents are selected and created over the Internet.

Costin (US 6,178,413 B1) teaches a method and system for automatic creation of documents.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

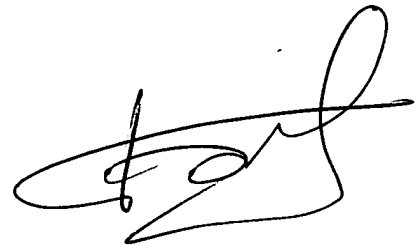
***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

Igor Borissov  
Patent Examiner  
Art Unit 3629

A handwritten signature in black ink, appearing to read 'Igor Borissov', with a large, stylized flourish extending from the end of the signature.

IB

12/23/2004